UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/484,772	01/18/2000	Jeffrey W. Small	30566.86US01	1090

55895   7590   09/06/2007
GATES & COOPER LLP
HOWARD HUGHES CENTER
6701 CENTER DRIVE WEST, SUITE 1050
LOS ANGELES, CA 90045

EXAMINER
LUDWIG, MATTHEW J

ART UNIT	PAPER NUMBER
2178	

MAIL DATE	DELIVERY MODE
09/06/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

United States Patent and Trademark Office

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

MAILED

Application Number: 09/484,772
Filing Date: January 18, 2000
Appellant(s): SMALL, JEFFREY W.

SEP 06 2007

Technology Center 2100

Jason S. Feldmar
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 3/8/2007 appealing from the Office action mailed

12/3/2004.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5,982,996	SNYDERS	11-1999
5,692,111	MARBRY	11-1997

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 5, 7-10, 12, 14, 15, 17-20, 22, 24, 25, 27-30, 32 and 34 are rejected under 35 U.S.C. 102(e) as being anticipated by Snyders (Patent # 5,982,996).

Regarding claim 5, 15, 25, Snyders teaches the claimed invention of associating multiple output device as shown in fig 1.

A computer with information (shown in fig 1, element 10) comprising a file generated by computer application (Col. 2, lines 12-14)

One or more printer (output device) configuration stored is shown in fig 9, element S7.24. Also see col. 2, lines 38-49.

Selecting information is shown in fig 7, element s3 and s6

Selecting one or more output device configuration is shown in fig 7, element s7 and col. 2, lines 38-49.

Associating information with output device configuration (shown in fig 10, element S7.26) by saving an association between selected information and output device configuration with the file (See col. 2, lines 28-49, wherein Snyders teaches generating a output file and retrieving one or more printer configuration and providing the file to print processor, retrieving printer configuration, retrieving printer document properties, (i.e. file properties with the printer properties that is equivalent to claimed association saved in memory) saving the new properties in the registry).

Regarding claims 7, 8, 17, 18, 27, 28, Snyders shows a information to be printed as a graphics or drawing file as shown in fig 7, element S3.

Regarding claims 9, 19, 29, Snyders teaches the claimed invention of obtaining setting of the printer and associating it with the information as shown in fig 9, element S7.22, S7.23 and S7.26.

Regarding claims 10, 14, 20, 24, 30, 34, Snyders teaches the claimed information of saving the setting as shown in fig 9, element S7.24

Regarding claims 12, 22, 32, Snyder teaches a printer as shown in fig 1, element 14, 16 and 18.

Claims 11, 13, 21, 23, 31 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Snyders (Patent 5,982,996) in view of Marbry et al. (Patent # 5,692,111).

Regarding claim 11, 21, 31, Snyders teaches the claimed invention as described above with respect to claim 1. Snyders does teach multiple printers to select from as shown in fig 1 but does not specifically teach listing the printer configuration and presenting list of printers as claimed. Marbry et al. does. Specifically, Marbry et al. teaches the claimed invention of listing available printers as described in col. 3, lines 20-22, Presenting the configuration information is described in col. 3, lines 30-35 and selecting one printer for printing is described in col. 3, lines 63-65. Therefore it would have been obvious for a person with ordinary skill in the art at the time the invention was made to include printer selection teachings of Marbry et al. in the method of Snyders because it provides easy access by organizing all available printer under one menu.

Regarding claims 13, 23, 33, Marbry et al. teaches selecting a printer whose configuration is not locally installed as described in col. 3, lines 25-30. This limitation is equivalent to claimed "none" selection as Marbry does teach obtaining the configuration and providing the access that is equivalent to selecting similar configuration.

(10) Response to Argument

In response to appellant's argument that neither Snyders nor Marbry teach, disclose or suggest associating an output device configuration with a particular file of information that is generated by a computer application and neither Snyders nor Marbry teach, disclose or suggest saving an output device configuration with a particular file generated by a computer application, the Examiner strongly disagrees and believes the claims fail to provide the explicit language required to sustain the arguments presented in appellant's appeal brief.

In reference to independent claims 5, 15, and 25, the Examiner would like to look at each of the three limitations separately. Furthermore, the Examiner will point out the reasons why, as a whole, the independent claims fails to overcome the prior art reference to Snyders. The first limitation states the following:

Selecting information comprising a file generated by a computer application

As presently claimed, the word information could be any type of software code related to a computer application. A computer application, as presently claimed, also is being interpreted broadly and therefore taught by the reference to Snyders. The reference discloses on column 2, lines 5-15 an application configured for running on the computer via the operating system, the application configured to generate a source job in the form of an intermediate file format

comprising an output instruction file. The apparatus includes a print processor in the form of an

intermediate executable code for operating on the output instruction file.

The reference to Snyders and more specifically, figure 9 illustrates printer (output device)

configuration data in relation to the second limitation which states the following:

Selecting one or more output device configurations

Furthermore, column 2, lines 35-55, discloses an computer application through the use of

a instructional file that retains new printer configuration data and saves data in the form of new

printer information in a system registry.

The last limitation states the following:

Associating said information with said one or more output device configurations by

saving an association between said selected information and said one or more selected output

device configuration with said file

Figure 10 illustrates an association and association information. The figure discloses a

method of saving an association between selected information and output device configuration

with the file. See column 2, lines 28-49. As presently claimed, the only step required to associate

said information is to saving the content. Snyders provides a broad interpretation of saving

association when the reference discloses the output file from application and configuration file

from the printer are saved. When the file is utilized, the output device configuration associated

with the file already exists and is associated with the file so no further configuration is necessary.

Appellant is reminded that generic words/terms such as 'selecting information', 'computer

application', and 'associating', leave the claim open to multiple interpretations and fail to

preclude the Examiner from utilizing the Snyders reference to provide a generic description of

each of the limitations of the claim and the invention as a whole.

The arguments presented on pages 9 and 10 focus on the whether the file is a similar file

as the one disclosed in the independent claims. However, the Examiner cannot make out any

language which states the file has to be a specific type of file. Therefore, when the reference to

Snyders discloses 'the apparatus has an application configured for running on the computer via

the source job in the form of an intermediate file format comprising an output instruction file.

The apparatus includes a print processor in the form of an intermediate executable code for

operating on the output instruction file' provides a similar teaching of a file utilized in the

association of output device configurations and saving those associations.

Regarding dependent claims 8, 18, and 28, the claims state 'information comprises a

layout of a drawing. Figure 7 illustrates data in intermediate drawing instructions (enhanced meta

file). The information presented within the figure would have been sufficient to allow for

software instructions to contain a layout of a drawing as known to one of ordinary skill in the art

at the time the invention was made.

Regarding dependent claims 10, 20, and 30, the claims state a step of 'saving said settings

with said information'.

The type of settings or any information defining the settings within the limitation of the

claim could not be found and therefore, a setting, as presently claimed, is taught by utilizing the

printer info that is found and saved in the system registry. The settings are related to the output

device configuration and therefore suggests and an association between settings and information.

Again, the generic language found throughout the limitations of the claims when read as a whole
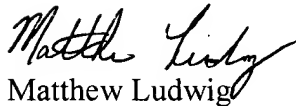
fails to preclude the Examiner from utilizing the Snyders reference to provide a generic

description of both information comprising a file, output device configuration data, and an

association between information with said one or more output device configurations by saving an

association with a file.

        For the above reasons, it is believed that the rejections should be sustained.

                      Respectfully submitted,

Matthew Ludwig
Assistant Patent Examiner
August 22, 2007

STEPHEN HONG
SUPERVISORY PATENT EXAMINER

Conferees:

Stephen Hong
Supervisory Patent Examiner

Doug Hutton
Supervisory Patent Examiner